



DAE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

THE MATTER OF: Charles ROSILIO, et.al.

SERIAL NO.: 09/914,455

FILED: August 27, 2001

GROUP: to be assigned

EXAMINER: to be assigned

FOR: METHOD FOR PRODUCING A TEMPLATE OF SEQUENCES OF
CHEMICAL OR BIOLOGICAL MOLECULES FOR A CHEMICAL OR
BIOLOGICAL ANALYSIS DEVICE

RE: RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Commissioner of Patents & Trademarks
Mail Stop Petition
P.O. Box 1450
Alexandria, VA 22313-1450
June 28, 2005

SIR:

Applicant respectfully petitions for reconsideration and withdrawal of the holding of abandonment of the above-captioned application. Applicant has received a Decision dated May 4, 2005 based upon a previous Petition to withdraw the holding of abandonment submitted on February 28, 2005, which denied applicants petition. The following "BACKGROUND" is provided, setting forth the events in chronological order of the prosecution from the first notification of a defective response.

BACKGROUND

1. February 21, 2002: First Notification of Defective Response indicating that no sequence listing (SL) had been submitted.

In response, applicant submitted a Hard copy SL and a diskette containing computer readable form (CRF) SL on April 18, 2002.

2. August 1, 2002: Second Notification of Defective Response, attached with a SL, pointing out that the diskette was "unreadable". The Second Notification did not specify or provide any information as to why the diskette was "unreadable" or indicate the presence of any defects in the sequence listing itself.

In response, applicant assumed the reason for the issuance of the Second Notification of Defective Response by the Office was that the previously submitted diskette was not readable because it was defective or had been infected by a computer virus. Therefore, applicant timely submitted a new diskette containing CRF sequence listing on August 23, 2002.

3. December 23, 2004: Notification of Abandonment without any detailed information.

At this time, applicant called the Patent Office to inquire as to the reasons for the abandonment and was informed, at such time, that the computer records showed that the response to the August 1, 2002 Notification was not connected to the file until October, 2004, which is more than two years after its submission. According to the Patent Office employee, abandonment was due to the excessive delay in submission of the response. Since applicant had proof, in the form of a stamped postcard, of timely submission of the August, 2002 response, applicant submitted, on February 28, 2005, a "Petition to withdraw holding of abandonment" enclosing a declaration to prove that applicant did make a timely response to the Second Notification of Defective Response. At no time was applicant informed of any defects in the sequence listing itself.

4. May 4, 2005: Decision from Office of PCT Legal Administration dismissing applicant's petition without prejudice. It was pointed out that the application remains abandoned for failing to provide a proper response to the Second Notification of Defective Response. For the first time, however, the existence of an "Error Report", dated Oct. 14, 2004, was clearly pointed out by the Office. The Raw Sequence Listing Error Report is dated October 14, 2004 and had not been enclosed with the December 23, 2004 Notification of Abandonment, nor was its existence identified during the inquiry following the Notification of Abandonment. Applicant would have corrected the sequence listing prior to re-submitting it with the February 28, 2005 Petition, if Applicant was aware of the "Error Report" before filing the previous petition.

In the Decision of May 4, 2005, the Office dismissed applicant's previous petition without prejudice, and for the first time clarified the misunderstanding between the Office and applicant by clearly pointing out the

existence of errors in the sequence listing itself, as the reason for the diskette being “unreadable”. Accordingly, applicant herewith submits an amended sequence listing, as well as a new diskette containing an amended Computer Readable Form sequence listing, which clearly overcomes the outstanding deficiency in the diskette.

The Holding of Abandonment should be withdrawn and no fee should be due for this Petition for the following reasons:

1. The definition of “unreadable” in the Second Notification of Defective Response is open to different interpretations as is evident from the MPEP in sections 1421.03, 608.05(e) and 2421.03 respectively.

MPEP 1421.03 recites that computer readable files which are defective, i.e., damaged in the mail, are not readable. Therefore, unreadability can be the result of mechanical damage, a computer virus or by an inconsistency in the format. Moreover, during the months following September 11, 2001 and until the establishment of the special sequence listing mail box, many sequence listing diskettes were damaged by mail processing in the Washington DC post office due to excess radiation as a result of the Anthrax scare. Since the sequence listing diskettes involved in this case were mailed during that period, and since no error report was included in the patent office notification, unreadability as a result of mail processing damage was also a probable and likely cause of damage.

Furthermore, in **MPEP 608.05 (e)**⁷, three kinds of files are given as examples of unreadable files, inclusive of (a) corrupted by a computer virus, (b) written onto a defective compact disc, or (c) a format that does not comply with the requirements of American Standard Code for Information Interchange. Accordingly, without a clear indication in the Notification of Defective Response it is unreasonable to assume that the word “unreadable” as used in the

Notification refers to a defect in the diskette itself. Accordingly, the previous response to the Second Notification of Defective Response is not improper per se and the holding of Abandonment should be withdrawn and no fee should be required.

As to a holding based on insufficiency of response, an applicant may reverse an examiner's holding as to whether or not an amendment received during such period was responsive and act on a case of such character which her or she has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. **MPEP 711.03(a)**.

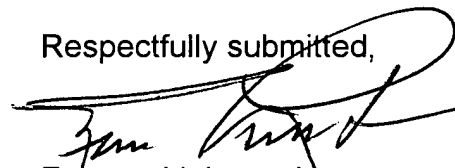
Upon detection of damage or a deficiency, a notice will be sent to the applicant detailing the damage or deficiency. **MPEP 2421.03**. In the Second Notification, the Office only identified the diskette as "unreadable." Although the Office attached the sequence listing to the end of the Notification, no comment or explanation, or indication of an error was identified. With no error indicated on the attached sequence listing, applicant concluded that the diskette was damaged and that a new diskette should be provided that would be "readable".

2. The Office failed to provide detailed information regarding the deficiency in the Second Notification of Defective Response. Instead, in the decision dated May 4, 2005, reference is made to a "Raw Sequence Listing Error Report" dated October 14, 2004, more than two years after the date of the Second Notification of Defective Response on August 1, 2002 and only one month prior to the date of Abandonment of December 23, 2004 to support dismissal of the Petition. In fact, applicant has never formally received the "Raw Sequence Listing Error Report" until May 4, 2005, along with the Decision dismissing applicants previous Petition.

Paragraph 3 of **MPEP 2421.03** clearly states that a notification of failure to comply with the sequence rules shall be accompanied by an analysis of any submitted computer readable form. The "Sequence Listing Error Report" did not spring to life until October 14, 2004. Clearly, the Office did not satisfy the requirement in MPEP 2421.03 in its Notification of August 1, 2002. Therefore, the response to the Second Notification of Defective Response made by applicant should not be deemed improper.

Accordingly, it is respectfully requested that the holding of abandonment be withdrawn and the attached amended sequence listing be made of record and that this petition be granted with no fee due.

Respectfully submitted,



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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, Mail Stop Petition, P.O. Box 1450, Alexandria, VA 22313-1450 on June 28, 2005.



Date: June 28, 2005